Immunocept, LLC, et al v. Fulbright & Jaworski Doc. 7

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

FILED
MAR 10 2006
CLERK, U.S. DISTRICT COURT
WESTERN DISTRICT OF TEXAS
BY DEPUTY CLERK

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON	§	
	§	
Plaintiffs,	§	
	§	
v.	§	CAUSE NO. A050A334 SS
	§	
FULBRIGHT & JAWORSKI, LLP,	§	
	§	
Defendant.	§	

DEFENDANT FULBRIGHT & JAWORSKI, LLP'S REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE THE TESTIMONY OF ALAN MacPHERSON

COMES NOW, Fulbright & Jaworski, LLP ("Fulbright"), and files this Reply in Support of Its Motion to Exclude the Testimony of Alan MacPherson, and in support thereof, would respectfully show the Court as follows:

Plaintiffs make the misleading claim that MacPherson has not ventured beyond the written record to proffer his opinion as to the rationale behind the PTO Examiner's determination that the Plaintiffs had overcome the Nosé reference. They quote in their brief the statement from MacPherson that "this argument was not only relied upon, it actually overcame the rejection based on Nosé et al. . . ." (Opposition, p. 6.) In light of the testimony cited in Fulbright's Motion to Exclude, Plaintiffs' obstinate insistence that MacPherson has not strayed from the written record is silly. Following is the sum total of the Examiner's "written" discussion of what overcame the Nosé reference:

> The declaration . . . filed 1/17/96 is sufficient to overcome the rejection of claims 1 - 8 based upon Lee et al. and Nosé et al.

(**Exhibit B**, F&J 02762) As discussed in the Motion to Exclude, the referenced declaration does

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not so much as mention the Nosé reference, and MacPherson acknowledges that he does not know the "true reason" for overcoming the reference. Nothing in the written record supports MacPherson's conclusion, and Plaintiffs proffer no evidence to the contrary.

Plaintiffs then go on to state that MacPherson should be permitted to testify as to Plaintiffs' "entitlement" to broader claim language, regardless of whether the Examiner would have accepted the hypothetical arguments and claims language suggested by MacPherson. The discussion is notable for its dearth of citation to authority. (Opposition, pp. 6-8.) It is also remarkable for its suggestion that "Mr. MacPherson will testify as to plaintiff's ***clear legal entitlement*** to broader claim coverage," as if there is a black-and-white answer to the question of whether a certain claim will issue from the patent prosecution process. MacPherson apparently does not share Plaintiffs' counsel's sanguinity:

> Q. Would . . . you be able to guarantee to a client, if you were involved in prosecuting the '418 patent, that they would have a claim issued just by differentiating the Nosé reference based on the molecular weight exclusion of the inventor's technology?
> A. Would I be able to guarantee?
> Q. Right.
> A. ***I think it's a good argument, and I don't guarantee.***
> Q. ***Would you be able to put a percentage chance of success on it?***
> A. I think it has merit to it.
> Q. What percent?
> A. ***I would hope that it would prevail, and that's all I would say.***
> Q. ***Your client asked you to handicap but you couldn't do it for him?***
> A. ***I don't handicap.***
> Q. Why not?
> A. I just don't.
> Q. It's too uncertain a process?
> A. ***I just don't do it. It's not my practice.*** And maybe others do, but I just say, I think this is a good argument and let's put it in and see if we can convince the examiner.

(**Exhibit C**, pp. 205-06.) MacPherson tacitly acknowledges that some arguments raised during the prosecution process will not be successful, and that he would not guarantee the success of any argument.

Finally, Plaintiffs spill little ink (and apparently spent no time to go look at a law book – again, they cite not a single authority) in attempting to pull their gross negligence claim out of the fire. They assert that, despite MacPherson's ignorance of the relevant standard of gross negligence and the fact that he did not evaluate components of that standard, he will be asked to testify as to various issues Plaintiffs claim are relevant to claims of gross negligence. It would be improper, however, for Plaintiffs to attempt to use MacPherson at the time of trial to establish elements of gross negligence that he assuredly did not raise in his expert report and as to which he was unprepared to testify at his deposition. For example, MacPherson should not be permitted to testify as to whether Fulbright's legal work, "when viewed objectively from the standpoint of the actor at the time of its occurrence involves an extreme degree of risk, considering the probability and magnitude of the potential harm to others." TEX. CIV. PRAC. & REM. CODE § 41.001(11). Whether Fulbright's actions, when viewed from the objective viewpoint of a patent attorney in 1996, involved an "extreme degree of risk," is assuredly a matter that requires expert testimony. *See Geiserman v. MacDonald*, 893 F.2d 787, 793 (5th Cir. 1990) ("In most legal malpractice cases, 'expert testimony is necessary to establish the standard of care since only an attorney can competently testify to whether the defendant comported to the prevailing legal standard.'"). But MacPherson cannot provide that necessary testimony: he acknowledged that he did not evaluate the degree of risk that might have been involved in a defendant's acts or omissions. (**Exhibit C**, p. 93.)

CONCLUSION AND PRAYER

Fulbright respectfully submits that the Court should exclude MacPherson's testimony regarding (1) the reasons that were or were not considered by the PTO Examiner in allowing the

'418 claims, (2) what alternative hypothetical claims wording the Examiner would have allowed, and (3) alleged gross negligence and elements thereof, and not permit him to testify at trial regarding those topics.

Respectfully submitted,

By: [signature]

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Telephone: (713) 951-3700
Facsimile: (713) 951-3720

ATTORNEYS FOR DEFENDANT FULBRIGHT & JAWORSKI, LLP

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing document was served as shown below on counsel of record on March 10, 2006.

Via Facsimile
Michael P. Lynn, P.C.
Jeffrey M. Tillotson, P.C.
John D. Volney
Jeremy Fielding
Lynn Tillotson & Pinker, LLP
750 N. St. Paul St., Suite 1400
Dallas, Texas 75201

[signature]
Connie H. Pfeiffer

Exhibit A

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON,	§	
Plaintiffs,	§	
v.	§	CAUSE NO. A050A334 SS
FULBRIGHT & JAWORSKI, LLP,	§	
Defendant.	§	

AFFIDAVIT OF CONSTANCE H. PFEIFFER

BEFORE ME, the undersigned notary public, on this day personally appeared Constance H. Pfeiffer, who being first duly sworn, upon his oath deposed and states as follows:

1. My name is Constance H. Pfeiffer. I am over 18 years of age. I am of sound mind, and I am competent to make this affidavit. I have personal knowledge of and am personally acquainted with the facts stated herein.

2. I am a licensed attorney in the State of Texas. I am an associate at the law firm of Beck, Redden, & Secrest, LLP and I represent Fulbright & Jaworski, LLP ("Defendant") in the above-captioned lawsuit. I have personal knowledge of and am personally acquainted with the discovery taken in the above-captioned lawsuit.

3. Attached hereto as **Exhibit B** is a true and correct copy of the United States Patent and Trademark Office Examiner's Action, dated April 16, 1996, which was produced in this litigation by Defendants and was marked as Exhibit 20 to the deposition of Marc Delflache.

4. Attached hereto as **Exhibit C** is a true and correct copy of excerpts from the Deposition of Alan MacPherson taken on January 27, 2006.

FURTHER AFFIANT SAYETH NOT.

CONSTANCE H. PFEIFFER

SUBSCRIBED AND SWORN TO before me on the 9th day of March, 2006

Elena Fitzgerald
Notary Public, State of Texas
My Comm. Expires 04/20/09

Notary Public In and For
the State of Texas
4-20-2009

388.00006/315476 1

Exhibit B

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/271,136	07/06/94	LEE	P D5563CIP

EXAMINER: KIM, S

A3M1/0416

ART UNIT	PAPER NUMBER
1306	8

PATENT DEPARTMENT
FULBRIGHT & JAWORSKI
1301 MCKINNEY, SUITE 5100
HOUSTON, TX 77010-3095

DATE MAILED: 04/16/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☑ Responsive to communication filed on 1/17/96 ☑ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ ______

Part II SUMMARY OF ACTION

1. ☑ Claims 1-8 are pending in the application.

   Of the above, claims ______ are withdrawn from consideration.

2. ☐ Claims ______ have been cancelled.
3. ☐ Claims ______ are allowed.
4. ☑ Claims 1-8 are rejected.
5. ☐ Claims ______ are objected to.
6. ☐ Claims ______ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on ______. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on ______, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed ______, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. ______ ; filed on ______.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 2/93)

F&J 02761

Deposition Exhibit
DeVache #20
Becky Landers, CSR

1. The declaration under 37 C.F.R. § 1.132 filed 1/17/96 is sufficient to overcome the rejection of claims 1-8 based upon Lee et al. and Nose et al.

2. Claims 1-8 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Okamoto et al. Okamoto et al. disclose a method of continuous arteriovenous hemofiltration (CAVH) of animal with microglobulin which may cause sepsis, shock, or multiorgan system failure (see col. 15, line 40 - col. 17, line 42). The hemofilter used in Okamoto et al. is polysulfone filter having an effective sieving coefficient of 0.5 to 1.0 for toxic mediators with a molecular weight of less than or equal to 60,000 daltons (see col. 16, line 59 - col. 17, line 42; Table 3 in col. 17, particularly comparable examples 3 and 4 for albumin). The polysulfone may be capable of passing molecules with a molecular weight of about 70,000 daltons in the presence of blood.

3. Applicant's arguments filed 1/17/96 have been fully considered but they are not deemed to be persuasive. Applicants argue that Okamoto et al. does not teach that their polysulfone filter has a molecular exclusion of 100,000 to 150,000 daltons. However, Okamoto et al. does teach that their polysulfone filter has low permeablility for albumin not more than 10% (see col. 3, lines 4-16) and this supports that their filter has a molecular exclusion of 100,000 to 150,000 daltons. Such evidence is

bolstered by the declaration under 37 C.F.R. § 1.132 filed 1/17/96 by applicants which states that the polysulfone filter used in the claimed method has an albumin of less than or equal to 50%.

4. **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (703) 308-2350. The examiner can normally be reached on Tuesday-Friday from 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 305-3602.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

Serial Number: 08/271136

Art Unit: 1306

John Kim
Primary Examiner
Art Unit 1306

J. Kim
April 12, 1996

Exhibit C

UNITED STATES DISTRICT COURT

WESTERN DISTRICT OF TEXAS - AUSTIN DIVISION

IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON,

Plaintiffs,

vs. Cause No. A050A334 SS

FULBRIGHT & JAWORSKI, LLP,

Defendants.

CERTIFIED COPY

VIDEOTAPED DEPOSITION OF ALAN MACPHERSON

DATE: Friday, January 27, 2006

TIME: 9:30 a.m.

LOCATION: MACPHERSON, KWOK, CHEN & HEID
1762 Technology Drive
Suite 226
San Jose, CA 95110

REPORTED BY: AUDREY KOLTERER, CSR NO. 11875

#22798

Advantage ARS Reporting Services, LLC

1083 Lincoln Avenue, San Jose, California 95125, Telephone (408) 920-0222, Fax (408) 920-0188

16:39:20 reference didn't not have the molecular weight exclusion of 100,000 to 150,000 Daltons.

16:39:30 Q. And without such a limitation wouldn't it cover the invention that the plaintiffs were seeking a patent for?

16:39:38 A. Well, it was cited by the examiner as anticipating the Claims 1 to 8, and the response points out that it doesn't anticipate because it lacks the exclusion of 100- to 150,000 Daltons.

16:40:00 Q. Do you believe that to be a correct argument?

16:40:10 A. Well, it seems to have been an argument that ultimately was successful.

16:40:16 Q. Do you believe it to be a correct argument?

16:40:17 A. I think so, yes.

16:40:18 Q. Based on what?

16:40:19 A. Based on the fact that this is an obvious exclusion that would work in this particular context.

16:40:23 Q. Would -- would it be -- would you be able to guarantee to a client, if you were involved in prosecuting the '418 patent, that they would have a claim issued just by differentiating the Nose reference based on the molecular weight exclusion of the inventor's technology?

16:41:13 A. Would I be able to guarantee?

16:41:19 Q. Right.

Advantage ARS Reporting Services, LLC

A. I think it's a good argument, and I don't guarantee.
Q. Would you be able to put a percentage chance of success on it?
A. I think it has merit to it.
Q. What percent?
A. I would hope that it would prevail, and that's all I would say.
Q. Your client asked you to handicap but you couldn't do it for him?
A. I don't handicap.
Q. Why not?
A. I just don't.
Q. It's too uncertain a process?
A. I just don't do it. It's not my practice. And maybe others do, but I just say, I think this is a good argument and let's put it in and see if we can convince the examiner.
Q. Okay.
Is it your understanding that the plaintiffs themselves believed that the Nose patent covered their invention?
A. There were a number of things in Nose that were different from what was done in '418 patent, and so I don't have any reason to believe that they did

Advantage ARS Reporting Services, LLC

I, AUDREY S. KOLTERER, duly authorized to administer oaths pursuant to Section 2093(b) of the California Code of Civil Procedure, do hereby certify that the witness in the foregoing deposition was by me duly sworn to testify the truth in the within-entitled cause; that said deposition was taken at the time and place therein cited; that the testimony of said witness was reported by me and thereafter transcribed under my direction into typewriting; that the foregoing is a complete and accurate record of said testimony; and that the witness was given an opportunity to read and correct said deposition and to subscribe the same.

Should the signature of the witness not be affixed to the deposition, the witness shall not have availed himself of the opportunity to sign or the signature has been waived.

I further certify that I am not of counsel nor attorney for any of the parties in the foregoing deposition and caption named nor in any way interested in the outcome of the cause named in said caption.

DATED:
JANUARY 30, 2006

Audrey Kolterer
AUDREY S. KOLTERER
CSR No. 11875